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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/950,059	09/10/2001	Guy S. Tallent JR.	10003-041	1529
20583	7590	12/02/2004	EXAMINER	
JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017				WINTER, JOHN M
ART UNIT		PAPER NUMBER		
		3621		

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<i>Office Action Summary</i>	Application No. 09/950,059	Applicant(s) TALLENT ET AL.
Examiner John M Winter	Art Unit 3621	

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 23 September 2004.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-3,5-15,17 and 18 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) 1-3 and 5-12 is/are allowed.  
6)  Claim(s) 13-15, 17-18 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

## DETAILED ACTION

Claims 1-3, 5-15 and 17-18 remain pending.

Claims 4 and 16 have been canceled.

### *Response to Arguments*

The Applicants arguments filed on September 23, 2004 have been fully considered.

The Examiner states that the feature of "the proposed authorization service is developed by a participant and approved by the policy management authority before being offered to a customer." is disclosed in the newly discovered reference Greene et al. (US Patent 6,449,598).

The Examiner further states that the amendment to claim 13 fails to overcome the 35 U.S.C 101 rejection because the amendment does not introduce the use of technology.

See following rejection.

### *Claim Rejections - 35 USC §101*

Claims 13-15, 17-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claim 13 only recites an abstract idea. The recited steps of merely "defining a proposed authorization service; presenting the proposed authorization service to a policy management authority; receiving approval of the proposed authorization service from the policy management authority, whereby the proposed authorization service becomes an approved authorization service; and implementing the approved authorization service" does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to authorize a service.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention implements an authorization service (i.e., repeatable) and defines an authorization service (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 13 is

deemed to be directed to non-statutory subject matter; claims 14-15 and 17-18 are dependant on claim 13 and are rejected for at least the same reasons.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-15, and 17- 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asay et al (US Patent 5,903,882) in view of Sudia et al (US Patent 6,209,091) and further in view of Greene et al. (US Patent 6,449,598).

As per claim 13

Asay et al ('882) discloses a method for establishing an authorization service, comprising:

presenting the proposed authorization service to a policy management authority;(Figure 7)

receiving approval of the proposed authorization service from the policy management authority, whereby the proposed authorization service becomes an approved authorization service; and implementing the approved authorization service.(Figure 3)

Asay et al ('882) does not explicitly disclose “defining a proposed authorization service;”, Sudia et al ('091). discloses “defining a proposed authorization service”.( Column 2, lines 25-29) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Asay et al ('882) method with the Sudia et al ('091) method in order in order to promote secure commerce.

Asay et al ('882) does not explicitly disclose “the proposed authorization service is developed by a participant and approved by the policy management authority before being offered to a customer.”, Greene et al ('598). discloses “the proposed authorization service is developed by a participant and approved by the policy management authority before being offered to a customer.”.( Column 8, lines 8-23) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Asay et al ('882) method with the Greene et al ('598) method in order in order to create more resilient policies.

As per claim 14,

Asay et al ('882) discloses the method of claim 13,

wherein the proposed authorization service comprises a messaging specification and implementation rules.(Column 12, lines 17-67 – column 14 line 4)

As per claim 15,  
Asay et al ('882) discloses the method of claim 13,  
wherein the proposed authorization service is jointly developed by a customer and its participant.(Column 10, lines 23-36)

As per claim 17,  
Asay et al ('882) discloses the method of claim 13,  
wherein the policy management authority is associated with a root entity.(Figure 7)

As per claim 18,  
Asay et al ('882) discloses the method of claim 13,  
wherein the approved authorization service is implemented within the context of a four-comer model.(Figure 2)

#### ***Allowable Subject Matter***

Claims 1-12 are allowable over the prior art record.

#### ***Conclusion***

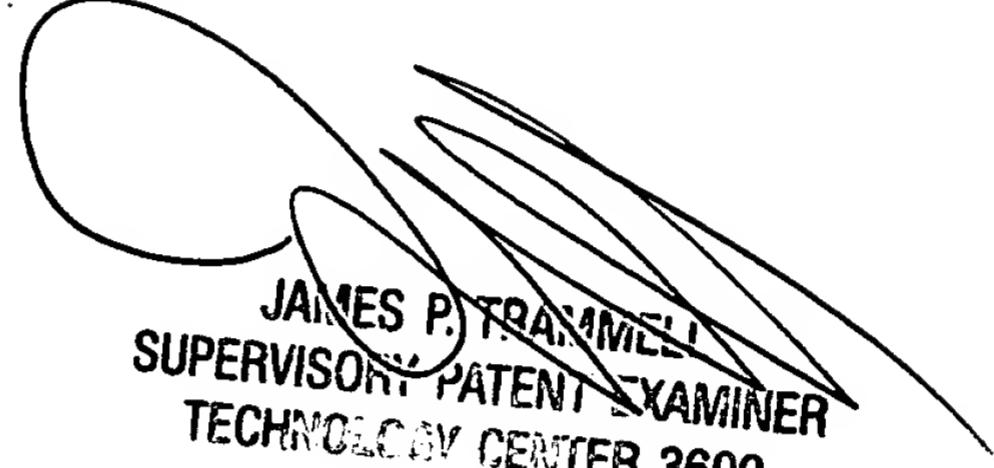
Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (703) 305-3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703)305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

JMW  
November 28, 2004



JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
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